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SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

4

DATE MAILED:

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on \_\_\_\_\_ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 57-68 are pending in the application.

Of the above, claims \_\_\_\_\_ are withdrawn from consideration.

2. ☐ Claims \_\_\_\_\_ have been cancelled.

3. ☐ Claims \_\_\_\_\_ are allowed.

4. ☒ Claims 57-68 are rejected.

5. ☐ Claims \_\_\_\_\_ are objected to.

6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has-(have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).

12. ☒ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received  
☐ been filed in parent application, serial no. 07/934667; filed on 01/22/93

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☒ Other Application should be typed on one side only

EXAMINER'S ACTION

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Claims 57-68 are pending.

Applicants are advised to re-submit the application (specification) retyped only on (part) one-side of the paper. (Patent Rule 1.52b). A substitute specification is required.

The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C. § 112, first paragraph, as failing to enable disclosure.

1. Claim 57 recites 'heteroaromatic' on lines 5 and 10 of page 3; 'heterocyclyl' on line 8 of page 2. These terms are unduly broad and indefinite (2nd para.) as found in the claim. Exactly what the rings are, has not been indicated. The instant claims 57-65 are compound claims. Therefore, <sup>one</sup> should be able, from a reading of the claim, determine what that claim does or does not encompass. Why? Because that claim precludes others

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from making, using, or selling that compound for 17 years.

Therefore, one must know what compound is being claimed.

Conception of what the intended 'heteroaromatic' or

'heterocyclyl' may be, should not be left to the reader.

Specification on page 5 in the last para. attempts to clarify as

follows: "The terms 'heterocyclyl' and 'heterocyclic' as used

herein include aromatic and non-aromatic, single and fused,

rings suitably (?) containing up to four hetero-atoms in each

ring selected from oxygen, nitrogen and sulphur.....". The

written description is considered inadequate here in the

specification. There are a large number of possibilities of the

relative configuration of the hetero atoms (1,2 1,3....etc.); For

example, hetero rings with two sulphur atoms in ortho-positions

are ~~difficult~~<sup>difficult</sup> to prepare and unstable. How is such a hetero

ring prepared? What are the starting materials ~~with~~<sup>for</sup> a hetero

(6) ring with O, N and S in 1,2,3 positions? In re Howarth 210

USPQ 689; In the absence of such data, the disclosure becomes

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merely an invitation to experiment. If you (the public) find that it works, I claim it, is not a proper basis for patentability; In re Kirk, 153 USPQ 48 at page 53.

The claims measure the invention. United Carbon Co. v. Binney & Smith Co. 55 USPQ 381, col. 1, end of 1st paragraph, Supreme Court of the United States (1942).

The U.S. Court of Claims held to this standard in Lockheed Aircraft Corp. v. United States, 193 USPQ 449, "Claims measure invention and resolution of invention must be based on what is claimed".

The C.C.P.A. in 1978 held "that invention is the subject matter defined by the claims submitted by the applicant". "We have consistently held that no applicant should have limitations of the specification read into a claim where no express statement of the limitation is included in the claim": In re Priest, 199 USPQ 11, at 15.

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Thus, the claims fail to set fixed metes and bounds to one skilled in the art. The specification is not commensurate with the broad scope of the claims.

Claims 57-68 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth in the objection to the specification.

Claim 68 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim is drawn to 'therapeutically effective amount'. It is not clear what the 'effective amount' is. The term 'therapeutically' fails to distinctly claim the invention, because it is not clear what the disease is.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner P.K. Sripada whose telephone number is (703) 308-4717. The fax phone numbers for this Group are (703) 308-4556 or 305-3592.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1235.

*Mukund J. Shah*  
MUKUND J. SHAH  
SUPERVISORY PATENT EXAMINER  
GROUP 1200

SRIPADA; aco *pr*  
July 12, 1996